Please amend the following claims:

3. (Amended) A method for creating a computer file readable by a pagination program for generating an output, comprising:

accessing a computer database;

identifying a record stored in said computer database;

adding a field directive to said record, wherein said field directive contains an instruction to said pagination program directing how said pagination program will format said output;

retrieving said record from said computer database;

adding computer code to said record to create said computer file, wherein said computer code makes said computer file readable by said pagination program;

transferring said computer file to said pagination program where said output can be generated;

identifying a first recipient of said output;

obtaining said first recipient's address information;

determining a number of orders made by said first recipient;

determining a monetary value of orders made by said first recipient;

determining a recency of orders made by said first recipient;

storing said number of orders;

storing said monetary value of orders;

storing said recency of orders;

calculating a first set of statistics regarding said number of orders, monetary value of orders, and recency of orders; and

determining whether to transfer said output to said first recipient based upon said first set of statistics.

5. (Amended) A computer program having control logic stored therein, said control logic, when executed, enabling a computer to generate a computer file containing a record received from a computer

database, add a field directive to said computer file, and convert said computer file to be compatible with a pagination program to develop an output, said control logic comprising:

accessing means for enabling said computer to access said record from said computer database;

coding means for identifying said record contained in said computer database;

coding means for adding at least one field directive, wherein said field directive provides an instruction to said pagination program directing how said pagination program will format said output;

coding means for converting said record into a computer file readable by said pagination program; and

coding means for transferring said computer file to said pagination program.

7. (Amended) A computer program having control logic stored therein, said control logic, when executed, enabling a computer to generate a computer file containing a record received from a computer database, add a field directive to said computer file, and convert said computer file to be compatible with a pagination program to develop an output, said control logic comprising:

accessing means for enabling said computer to access said record from said computer database;

coding means for identifying said record contained in said computer database;

coding means for adding at least one field directive, wherein said field directive provides an instruction to said pagination program [to said pagination program] directing how said pagination program will format said output;

coding means for converting said record into a computer file readable by said pagination program;

coding means for transferring said computer file to said pagination program;

coding means to identify a first recipient of said output;

coding means to obtain said first recipient's address information;

coding means to determine a number of orders made by said first recipient;

coding means to determine a monetary value of orders made by said first recipient;

coding means to determine a recency of orders made by said first recipient;

coding means to store said number of orders;

coding means to store said monetary value of orders;

coding means to store said recency of orders;

coding means to calculate a first set of statistics regarding said number of orders, monetary value of orders, and recency of orders; and

coding means to determine whether to transfer said output to said first recipient based upon said statistics.

9. (Amended) A method for converting at least two records stored in a computer database into a computer file readable by a pagination program, by:

finding and retrieving a first record and a second record, each contained in said computer database;

adding a first field directive to said first record and a second field directive to said second record that will act as instructions to said pagination program to create a desired output;

generating said computer file from said records;

adding computer code to said computer file so as to make said computer file readable by said pagination program; and

transferring said computer file to said computer pagination program.

13. (Amended) A method of converting a record of a first product stored in a computer database into a computer file readable by a pagination program, comprising:

controlling a computer system to create a file template;

controlling said computer program to select said record of said first product from among multiple product records stored in said computer database;

using said file template to add a field directive to said record of said first product, said field directive containing instructions used by said pagination program for formatting an output;

adding computer code to said record of said first product in order to create a computer file that is readable by said pagination program;

transferring said computer file to said pagination program;

a first field directive containing Aframe information, wherein said Aframe information comprises a computer file name of an image stored in said database and associated with said first product, a computer path to said image, and an Aframe identification code;

a second field directive containing table information, wherein said table has instruction used by said pagination program to set the number of columns of said output, the widths of each of said columns, the contents of a header of each of said columns, the contents of a row, a subheading title, closing tags for said table, and a table identification code; and

a third field directive containing text flow information, wherein said text flow information comprises said first product's manufacturer, said first product's group, said first product's subheading, said first product's sales point, said first product's features, said first product's Aframe identification code, and said first product's table identification code.

Please add the following claims:

17. A method for creating a computer file readable by a pagination program for generating an output, comprising:

accessing a computer database;

identifying a record stored in said computer database;

adding a field directive to said record, wherein said field directive contains an instruction to said pagination program directing how said pagination program will format said output;

retrieving said record from said computer database;

adding computer code to said record to create said computer file, wherein said computer code makes said computer file readable by said pagination program;

transferring said computer file to said pagination program where said output can be generated; and

generating said output, wherein said output is a printed document.

18. The method of Claim 17, further comprising:

identifying a first recipient of said output;

obtaining said first recipient's address information;

determining if said first recipient has a characteristic, said characteristic consisting of at least one of: a bad account, a closed account, a competitor, a prior recipient, a non-orderer, or an undesirable physical location;

terminating transfer of said output to said first recipient at said address if said first recipient has said characteristic; and

transferring said output to said first recipient if said first recipient does not have said characteristic.

19. A computer program having control logic stored therein, said control logic, when executed, enabling a computer to generate a computer file containing a record received from a computer database, add a field directive to said computer file, and convert said computer file to be compatible with a pagination program to develop an output, said control logic comprising:

accessing means for enabling said computer to access said record from said computer database;

coding means for identifying said record contained in said computer database;

coding means for adding at least one field directive, wherein said field directive provides an instruction to said pagination program directing how said pagination program will format said output and wherein said output is a printed document;

coding means for converting said record into a computer file readable by said pagination program; and

coding means for transferring said computer file to said pagination program.

20. The computer program of Claim 19, further comprising:

coding means to identify a first recipient of said output;

coding means to obtain said first recipient's address information;

coding means to determine if said first recipient has a characteristic, said characteristic consisting of at least one of: a bad account, a closed account, a competitor, a prior recipient, a non-orderer, or an undesirable physical location;

coding means to terminate transfer of said output to said first recipient at said address if said first recipient has said characteristic; and

coding means to transfer said output to said first recipient if said first recipient does not have said characteristic.

REMARKS/ARGUMENTS (37 CFR 1.111)

Applicant has considered all points made by the Examiner in the Office Action and has incorporated Examiner's suggestions to ensure compliance with the applicable rules.

Applicant amended the claims to clarify the structure that Applicant believes distinguishes the present invention over the cited references, to clarify the function of the claimed invention, and to clarify the limitations within the claims drawn to such a structure. However, such amendments have not been

made to narrow the claims of the original application, but rather simply to clarify claims due to grammar that the Examiner found unclear.

The examiner has indicated that Claims 3, 4, 7, 8, 13, and 14 would be allowable if amended to overcome the 35 U.S.C. §102 rejections and to include all limitations of the base claim and any intervening claim(s). Inasmuch as these claims have been amended accordingly, it is respectfully submitted that Claims 3, 4, 7, 8, 13, and 14 are now in a condition for allowance.

1. Claim Objections

The Examiner has objected to Claim 5 due to a typographical error in the claim. Specifically, Claim 5 included a duplication of the phrase "to said pagination program" at line 9. The duplication was a typographical error. Applicant has amended Claim 5 by deleting the duplicative "to said pagination program," such that the above-referenced typographical error is no longer included in Claim 5.

2. 35 U.S.C. §112 Rejection

The Examiner has rejected Claim 15 pursuant to 35 U.S.C. §112 on the basis that it contains the trademark/trade names FILEMAKER and FRAMEMAKER. The Examiner believes that said trademark/trade names were used in Claim 15 as limitations to identify or describe a particular material or product, specifically a commercial database and a commercial pagination program. The Examiner argues that trademark/trade names are used to identify the source of the goods, not the goods themselves. And thus, the Examiner believes the use of FILEMAKER and FRAMEMAKER in Claim 15, makes the claim indefinite and fails to comply with §112.

Applicant hereby cancels Claim 15 without prejudice to refiling it at a later date and without any admission that it is not patentable. The cancellation reduces the subject matter before the Examiner and, hopefully, expedites the process of reaching agreement on the language for the remaining claims.

3. 35 U.S.C. §102 Rejection

Claims 1, 5, 9-11 were rejected under 35 U.S.C. §102(e) as being anticipated by Makipaa (US 6,556,217). Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the Examiner to identify in a single prior art reference disclosure of each and every element of the claims in issue, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); In re Schaumann, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue).

When determining if a prior art reference anticipates a claim containing elements expressed as a means for performing a function pursuant to 35 U.S.C. § 112, last paragraph, "the limitations which must be met are those set forth in each statement of function." RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1445 n.5, 221 U.S.P.Q. 385, 389 (Fed. Cir. 1984).

When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, the reference does not anticipate. Akzo N.V. v. U.S. Int'l Trade Comm'n, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), cert. denied,482 U.S. 909, 107 S.Ct. 2490 (1987).

Applicant respectfully traverses the rejection of Claims 1, 5, 9-11. Without limitation, Makipaa discloses a method for resizing a display screen so that the display screen may be displayed on a "...user terminal having any size screen." It does not disclose each of the elements of Claim 1. Without limitation, the claim of "adding a field directive to said record, wherein said field directive contains an instruction to said pagination program directing how said pagination program will format said output" in Claim 1 is not found in Makipaa. The Examiner argues that col. 7, lines 5-7 is readable on this portion of Claim 1, however Makipaa describes a completely different process. Makipaa takes an existing "page" and uses the "user and terminal profiles ... and the device translation table" (Makipaa col. 7, lines 5-6), to resize the content to be displayed. The information that Makipaa uses is not an added field, but rather is a set of characteristics that the terminal has to which the "page" must be resized. See (Makipaa col. 7, lines 55-61) Thus, a field directive is never added to any record in Makipaa. Additionally, the information in the "user and terminal profiles ... and the device translation table" is not used by Makipaa to direct a

pagination program to direct how output will be formatted, rather it is used as information to determine the size of the terminal. Conversely, Applicant's invention field directive that is added to a record that follows the record an directs later pagination. Makipaa makes no mention of aspects of Applicant's invention and does not anticipate Claim 1.

Regarding Claim 5, please incorporate the same arguments as set forth above regarding Claim 1.

Regarding Claim 9, please incorporate the same arguments as set forth above regarding Claim 1. Additionally, Makipaa does not disclose using a first and second record for the same output. Because Makipaa is designed to resize web-pages, it works on a single page, and thus actually teaches away from Applicant's invention that is designed to be able to take multiple records and paginate them for output.

Regarding Claim 10, please incorporate the same arguments as set forth above regarding Claim 9.

Regarding Claim 11, please incorporate the same arguments as set forth above regarding Claim 9.

Claim 12 was rejected under 35 U.S.C. §102(e) as being anticipated by Sutcliffe (US 6,253,216). Applicant respectfully traverses the rejection of Claims 1, 5, 9-11. Without limitation, Sutcliffe discloses a method for personalizing a stock web-page on a "personals" web-server. It does not disclose each of the elements of Claim 1. Without limitation, the claim of "controlling a computer system to create a file template" is not disclosed by Sutcliffe. While Sutcliffe does disclose using an existing template, the templates in Sutcliffe are preset. This is evidenced by the intent of the Sutcliffe disclosure, which is to make personalizing a web-page from an existing template. Applicant's invention, as claimed in Claim 12, includes the creation of the file template. Additionally, Sutcliffe makes no mention of a pagination program.

Thus, neither patent cited by the Examiner discloses each and every element of the claims at issue.

4. 35 U.S.C. §103(a) Rejections

Pursuant to 35 U.S.C. §103(a), the Examiner has rejected Claims 2 and 6 on the basis that such claims obvious in light of Makipaa in view of Sutcliffe. Applicant notes that the written office action did

not include any discussion of reason for Examiner's rejection of Claim 6, but that in a telephone conference with Applicant's attorney, the Examiner indicated Claim 6 was being rejected for the same reasons as Claim 2.

These references cannot be combined in that they are unrelated, and neither patent suggests the use of the other. All of the elements of Claim 2 as depending from Claim 1, and Claim 6 as depending from Claim 5, are not disclosed or suggested by the references. The first element Examiner discusses is the obtaining of the first recipient's address information. The second element also involves the first recipient, however in Sutcliffe, who the Examiner uses as the first recipient changes. Specifically, in Sutcliffe col. 4, lines 1-5, an operator takes identification information from a client who would like to place a personals advertisement, while in col. 10, lines 32-37, Sutcliffe describes giving a viewer permission to view the personal advertisement. Conversely, Applicant's invention provides cost containment in allowing the catalogue developer to weed out bad customers. The first recipient is the same "person" in Applicant's invention. Additionally, Sutcliffe describes a client giving permission to another person to view their advertisement, which does not suggest determining the status of the first recipient's account as claimed by Applicant. Additionally, none of the elements of the "characteristic" are disclosed or suggested by the references. Additionally, Sutcliffe uses the permission to allow viewing of the personals ad, while Applicant's invention uses the characteristic to stop the sending of a catalogue to a poor customer. Finally, in regard to Claim 6, Sutcliffe discloses an operator obtaining the identification and address information, not the computer program.

For these reasons, without limitation, the cited references are unrelated to Applicant's disclosure and claims. That is, Sutcliffe specifically teaches away from Applicant's invention. The functionality described in Sutcliffe is to provide a personalized "personals" web-page. In contrast, Applicant's invention is directed at creating product catalogues. As stated above, the references cannot be combined, because nothing in either patent suggests the use of the other. However, even if they are combined, in no way do they suggest or teach Applicant's invention.